REMARKS

Applicant thanks the Examiner for the consideration given the present application. Claims 23-31 are pending and stand rejected. Please consider the following remarks.

The Rejection Under 35 U.S.C. § 102(b)

The Examiner has rejected Claims 23-31 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 3,681,091, to Kohl et al. The Applicant respectfully traverses this rejection.

In the previous amendment, the claims that were not drawn to a method were cancelled, and the method claims were amended according to the Examiner's suggestion. More specifically, the Examiner stated that method claims containing the language:

> "a method of treating dental erosion comprising orally administering to a mammal in need thereof an effective amount of a beverage composition..."

are allowable based on the CAFC decision in *Jansen v. Rexall,* 342 f.3d 1329 (Fed. Cir. 2003).

The Examiner now asserts that statements made during prosecution obviate the amendments. The Applicant respectfully disagrees. The *Jansen* case does not require, as the Examiner suggests that the person using the presently claimed beverage be instructed to do so by, for example, a doctor. The *Jansen* decision merely requires that the "need be appreciated". In the present case, it is notoriously well known that acidic beverages, which include most colas, fruit flavored and fruit based beverages, slowly erode tooth enamel. Thus, the "need" in the present case is known and appreciated by consumers.

Moreover, the *Jansen* case deals with scope of enforceability rather than patentability of the claims. The present claims, like the claims in *Jansen* are patentable, but the decision sets forth limits on how the claims can be infringed. In *Jansen* a competitive product, which fell within the literal scope of the composition claimed, did not infringe because the alleged infringing product did not recommend taking the vitamin supplement to combat the form of anemia claimed. As such, there was no direct infringement by the consumer, because there was no proof they were taking the supplements to combat their anemia.

As such, the claims in the present case are patentable. And the *Jansen* decision clearly lays out the metes and bounds of enforceability for claims such as these.

Accordingly, the Applicant respectfully requests that the present rejection be withdrawn and the claims be allowed.

CONCLUSION

It is respectfully submitted that the Examiner's rejection of Claims 23-31 under 35 U.S.C. §§ 102 (b), has been overcome. A withdrawal of this rejection and the issuance of a prompt Notice of Allowability is therefore respectfully requested.

Respectfully submitted,
For: GARY (NMN) STEPHENSON

By_____
S. Robert Chuey
Attorney for Appellants
Registration No. 39,140
Telephone: (513) 634-0102

Date: September 6, 2005

Customer No. 27752